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In re Application of:

Frederick, et al

Application No.: 10/775,353

Art Unit: 3733

Filed: February 10, 2004

Examiner: James L. Swiger, III

For: Acetabular Reamer

Docket No: 10557/293163

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Sir:


Responsive to the Non-Final Office Action dated March 10, 2006 ("the first Office Action"), and Final Office Action dated October 20, 2006, ("the Final Office Action"), Applicants request a pre-appeal brief review in the application identified above. A concise statement setting forth the reasons for the request is set forth below.

REASONS FOR THE REQUEST

The Final Office Action maintained all of the claim rejections from the First Office Action, in spite of the claim amendments and the arguments that Applicants presented in the Amendment and Response to the Office Action filed August 3, 2006 ("the Response"). The claim rejections include (1) a rejection of Claims 1-5 and 8 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent Serial No. 5,775,719 to *Frieze et al.* ("*Frieze*"), (2) a rejection of Claims 1-9 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent Application Publication No. 2005/0075639 to *Lechot* ("*Lechot*"), and (3) a rejection of Claims 10-12 as obvious under 35 U.S.C. § 103(a) over *Lechot* in view of U.S. Patent Application Serial No. 5,116,165 to *Salyer* ("*Salyer*").

As for (1), Applicants assert that the First Office Action and the Final Office Action ("the Office Actions") failed to establish a basis for rejecting Claims 1-5 and 8 under 35 U.S.C. § 102(b) in light of *Frieze* at least because they failed to establish, as required in MPEP 2131.01, that *Frieze* taught all of the elements of independent Claim 1. As for (2), Applicants assert that the Office Actions failed to establish a basis for the rejection of Claims 1-9 under 35 U.S.C. § 102(e) in light of *Lechot* at least because they failed to establish, as required in MPEP 2131.01, that *Lechot* taught all of the elements of independent Claims 1 and 9. As for (3), Applicants assert that the Office Actions failed to establish a *prima facie*

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basis, as required in MPEP 2142, for rejecting Claims 10-12 under 35 U.S.C. § 103(a) over *Lechot* in view of *Salyer*, at least because the Office Actions failed to establish that the cited references taught or suggested, separately or in combination, all of the limitations of the rejected claims, and further because there is not a suggestion or motivation in *Lechot* or *Salyer* to combine or modify the references as suggested in the Office Actions. Applicants respectfully request the review of the erroneous rejections in view of the Remarks set forth below and in view of the previous arguments by Applicants. Additionally, the Final Office Action objects to duplicate Claim 13, which was listed in the Response as a result of a typographical error. Applicants request the review and withdrawal of the objection as clearly unnecessary.

REMARKS

Pending Claims and Claim Objections

Claims 1-12 are pending after the Response. Of those, Claims 1 and 9 are independent. Claims 2-8 depend, directly or indirectly, from Claim 1. Claims 10-12 depend, directly or indirectly, from Claim 9. The Final Office Action objects to duplicate Claim 13. Duplicate Claim 13 was listed in the Response as a result of a typographical error, which was clear from the Response.

On page 6, first and second paragraphs of the Response, Applicants affirmed the election of Claims 1-12 for further prosecution in response to the Restriction Requirement, cancelled Claims 13-23 and stated that Claims 1-12 were pending. Applicants identified Claim 13 as "Cancelled" on p. 4 of the Response. However, as a result of an unintentional typographical error, duplicate Claim 13 was listed as "Original" on pp. 3-4 of the Response. Based on Applicants' statements on p. 6 of the Response, it is clear that the duplicate listing of Claim 13 was a result of a typographical error, that the correct amendment was clear from the context and that, in the interest of expediting prosecution, the correct amendment should have been entered by Technology Center as provided in MPEP 714(II)(G). Applicants therefore request that the objection raised in the Final Office Action be withdrawn.

Rejection of Claims 1-5 and 8 under 35 U.S.C. § 102(b) in light of *Frieze*

Claims 1-5 and 8 are rejected under 35 U.S.C. § 102(b) in light of *Frieze*. Anticipation requires the cited reference to teach each and every element of the claim. See MPEP 2131.01. *Frieze* does not teach at least one element recited in Claims 1-5 and 8, namely, a second portion not forming a surface of rotation that is generally located closer to the axis of rotation than the first portion. At least in view of the foregoing, *Frieze* fails to anticipate Claims 1-5 and 8.

On p. 7, the First Office Action stated that *Frieze* disclosed a reamer having a first portion dimensioned as a surface of rotation, and a second portion not forming a surface of rotation. On page 8, the First Office Action included an annotated drawing of Figure 1 from *Frieze*. The reamer in *Frieze* is composed of semi-circular interlocking sections, with outer serrated edges forming a rotational surface of the reamer. The triangular shapes in the annotated drawing appeared to indicate portions of the *Frieze*

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reamer that the Office Action considered to read on "a second portion," as recited in Claim 1. On p. 10 of the Response, Applicants pointed out that the triangular shapes in the annotated drawing corresponded to holes in the *Frieze* reamer, rather than to parts of a surface of the reamer, as required by Claim 1. After considering the Response, the Final Office Action defined a surface as "any outward portion not facing inward," and stated that that the relevant element in Figure 1 of *Frieze* was the "side portion" because it "faces outward." See "Response to Arguments," Final Office Action, p. 2, 2nd paragraph.

Applicants assert that the Office Actions failed to establish that *Frieze* taught all elements of Claim 1. The holes between the interlocking parts in the *Frieze* reamer are not portions of a reamer surface, and, therefore, cannot read on Claim 1 and its dependent claims. It is not clear what the Final Office Action meant by the "outward" surface with regard to *Frieze*. If the Final Office Action is referring to the planar sides of the interlocking *Frieze* blades, they are not portions of a reamer surface within the meaning of the present application. Claim 1 requires for the "second portion" to be a portion of the surface of the dome shaped hollow body of the reamer. See Response, p. 11, 1st full paragraph. The planar sides of the semicircular sections of the *Frieze* reamer are not portions of the dome shaped surface. Further, Claim 1 requires for the second portion to reduce a dimension of a dome in at least one dimension transverse to the rotational axis of the dome. The planar sides of the semicircular section of the *Frieze* reamer do not reduce a transverse dimension of a reamer dome shaped surface. At least for the above reasons, *Frieze* fails to teach all elements of a reamer, as claimed in Claim 1 and its dependent claims, and Applicants respectfully request that the erroneous rejection based on *Frieze* be reconsidered and withdrawn.

Rejection of Claims 1-9 under 35 U.S.C. § 102(b) in light of *Lechot*

Claims 1-9 are rejected under 35 U.S.C. §102(e) in light of *Lechot*. Anticipation requires the cited reference to teach each and every element of the claim. See MPEP 2131.01. *Lechot* does not teach at least one element recited in Claims 1-8, namely, a second portion not forming a surface of rotation that is generally located closer to the axis of rotation than the first portion. *Lechot* does not teach at least one element recited in Claims 9, namely, a limitation that the raised edges are confined to one or more sectors of the surface of the reamer, the sectors occupying substantially less than half of area of the surface of the reamer. At least in view of the foregoing, *Frieze* fails to anticipate Claims 1-9.

As for the rejection of Claims 1-8 in light of *Lechot*, the First Office Action asserted on pp. 4-5 that *Lechot* disclosed a reamer with a first portion and a second portion (50) that (1) did not form a surface of rotation and (2) was closer to the axis of rotation. This section of the First Office Action appeared relevant to the rejection of Claim 1 and its dependent Claims 2-8. In the Response, Applicants pointed out that element (50) of the *Lechot* reamer was, in fact, a cut away section of the dome shape. See Response, p. 10, bottom, through p. 11, 1st full paragraph. The cut away portion does not form a "second portion" recited in Claim 1 at least because it is empty space and not a part of a reamer surface, as is

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required by the claim. On p. 2, the Final Office Action re-asserted that "the sides [of 50] create a second surface facing outwardly." Applicants respectfully reiterate that notation "50" in *Lechot* is used to denote portions "that have been removed in the manufacturing process" and therefore cannot be interpreted as portions of an existing reamer surface. See *Lechot*, p. 3, paragraph 0033. If the Final Office Action refers to the edge or the rim of the reamer, where a portion (50) has been cut off, Applicants point out that the edge or the rim is not a portion of the domed-shaped surface, as required by Claim 1. At least for the above reasons, *Lechot* fails to teach a reamer, as claimed in Claim 1 and its dependent claims, and Applicants respectfully request that the erroneous rejection of these claims based on *Lechot* be reconsidered and withdrawn.

As for the rejection of Claim 9, the Office Actions appear to assert that *Lechot* teaches that a reamer surface may be divided into any manner of sectors, some with raised cutting edges and some without, with the former occupying less than half of the surface area of the reamer. See First Office Action, pp. 4-5, and Final Office Action, pp. 2 and 5. In the Response, Applicants pointed out that, contrary to the Office Actions' interpretation of its teaching, *Lechot* emphasizes that the cutting teeth are arranged uniformly on the reamer surface, and that, in *Lechot*, whenever there is a sector, it always contains part of a tooth. See Response, p. 11, 2nd and 3d full paragraphs. Therefore, *Lechot* does not allow the possibility of tooth-free sectors on the surface of a reamer, as in Claim 9. At least for the above reasons, *Lechot* fails to teach a reamer, as claimed in Claim 9, and Applicants respectfully request that the erroneous rejection be reconsidered and withdrawn.

Rejection of Claims 10-12 under 35 U.S.C. § 103(a) as obvious in view of *Lechot* and *Salyer*

The Office Actions rejected Claims 10-12 as obvious under 35 U.S.C. § 103(a) in view of *Lechot* in combination with *Salyer*. To establish a *prima facie* case of obviousness, the references, separately or combined, must teach or suggest all the claim limitation, and the teaching or suggestion to make the claimed combination must be found in the prior art. See MPEP 2142. *Lechot* and *Salyer*, separately or in combination, do not teach or suggest at least two limitations recited in Claims 10-12: a limitation that the raised edges are confined to one or more sectors of the surface of the reamer, the sectors occupying substantially less than half of area of the surface of the reamer; and a limitation that the raised edges are confined to a band straddling a middle portion of the dome shape. Further, there is not suggestion or motivation in *Lechot* or *Salyer* to combine or modify the references as suggested in the Office Actions. Accordingly, *Lechot* or *Salyer*, separately or in combination, fail to render Claims 10-12 *prima facie* obvious at least for the foregoing reasons.

The Office Actions assert that *Lechot* discloses the claimed invention, except for the cutting edges being confined to a band in the middle portion of the dome shape. See First Office Action, p. 5, and Final Office Action, pp. 5-6. Applicants disagree. Applicants assert that, for at least the reasons discussed in the previous section and arguments provided on pp. 10-11 of the Response, *Lechot* fails to

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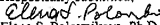
teach a reamer, as recited in Claims 9. *Lechot* also fails to suggest or provide a motivation to derive a reamer, as recited in Claim 9. Even if the reamer recited in Claim 9 is modified in Claim 10 based on *Salyer*, as the Office Actions suggested, such a combination would fail to result in a reamer recited in Claims 10-12. Accordingly, rejection of Claims 10-12 as obvious under 35 U.S.C. § 103(a) in view of *Lechot* in combination with *Salyer* is improper at least because *Lechot* fails to teach all of the elements of the rejected claims.

The First Office Action characterized *Salyer* as disclosing cutting edges placed on the cutting surface in "in form and function a band of cutting edges," thereby reading on the limitation recited in Claim 10. See First Office Action, p.5. Applicants included copies of Figures 1-3 from *Salyer* into the Response on p. 10 and pointed out that *Salyer* fails to teach or suggest confining the raised edges to a band-like formation on the surface of the reamer as required by Claims 10-12. Furthermore, *Salyer* teaches away from the reamer recited in Claims 10-12 because it shows at least in Figure 2 that any band with the cutting edges occupies more than half of the surface of its reamer, contrary to what is recited in Claims 10-12. Thus, not only *Salyer* fails to teach or suggest confining raised edges to a band, as recited in Claim 10-12, *Salyer* teaches away from modifying a reamer recited in Claim 9 because, in the first place, it teaches away from confining the cutting edges to less than half of a reamer surface, as recited in Claim 9. Applicants previously provided arguments as to why the motivation to derive the structures recited in Claims 10-12 is absent from *Salyer* or *Lechot*. See Response, pp. 12-13. In view of the foregoing and the previously submitted arguments, Applicants assert that the Office Actions failed to establish *prima facie* basis, as required in MPEP 2142, for rejecting Claims 10-12 under 35 U.S.C. § 103(a) over *Lechot* in view of *Salyer* at least because the Office Actions failed to establish that the references taught, separately or in combination, all of the limitations of the rejected claims, and further because there is not suggestion or motivation in *Lechot* or *Salyer* to combine or modify the references as suggested in the Office Actions. Applicants respectfully request the review of the erroneous rejections of Claims 10-12, reconsideration of the rejections and their withdrawal.

CONCLUSION

For the reasons set forth above, Applicants respectfully request that the pending claims be allowed.

Respectfully submitted,


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